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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,980	01/04/2005	Hirohisa Tanaka	71465.00009	3217
7590	10/25/2005		EXAMINER	
Dickinson Wright 1901 L St N W Suite 800 Washington, DC 20036			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,980

Applicant(s)

TANAKA ET AL.

Examiner

Cam N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 04, 2005 (a 371 of PCT/JP03/08437)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date originally filed.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1 & 6 are objected to because of the following informalities:
 - A. In claim¹₆, last line, "Co, Rh and the rare-earth elements, and Al" should be changed to --Co, Rh, the rare-earth elements, and Al--.
 - B. In claim 6, in the formula, "ABRhO3" should be changed to --ABRhO₃--.Appropriate correction is required.
2. Claim 6 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

There is no patentable distinction seen between the catalyst of claim 6 and the catalyst of claim 1.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 3 & 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/520,824 (hereinafter copending '824) in view of Monceux et al., "hereinafter Monceux", (US Pat. 5,622,680).

The difference between the instantly claimed catalyst and that of copending '824, is that the catalyst of copending '824 requires Pt in the chemical formula and wherein A' is selected from the alkaline earth metals and Ag.

It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have modified the claimed catalyst by substituting the Pt for the Rh and adding the alkaline earth metals in order to achieve an effective catalyst, such as the catalyst of copending '824, because it is known and taught by Monceux to use Pt and alkaline earth metals to make catalyst (see Monceux at col. 1, ln 40-57).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102(e)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaneko et al., "hereinafter Kaneko", (US Pat. 6,800,388 B2).

Kaneko discloses a catalyst composition which comprises: a perovskite composite oxide having the formula ABO_3 and the formula $A'_{1-x}A''_xB'_{1-y}B''_yO_3$, wherein A' is La, Ce or both, A' is at least one element selected from the group consisting of La, Ca, Sm, Ce, Sr, Ba and Pr, B' is at least one element selected from the group consisting of Co, Fe, Mn and Gd, and B'' is at least one element of noble metals, etc. (see col. 18, claim 1). See also Table 4 in col. 17.

There is no patentable distinction seen between the claimed catalyst and that disclosed by Kaneko, thus the claims are anticipated.

Claim Rejections - 35 USC § 102(b)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Monceux et al., "hereinafter Monceux", (US Pat. 5,62,680).

Monceux discloses a catalyst containing an active phase of the perovskite-type

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structure having the general formula: $L_x L'_{1-x} M_y M'_z \Phi_{1-y-z} O_3$, wherein L is an element selected from the lanthanides and the rare earth metals, L' is an element selected from Sr, Ca, Ba, Ce, K, Bi, Rb and Na, M is a transition metal selected from Cr, Mn, Fe, Co, Ni and Cu, M' is at least one metal selected from Pt, Ru, Pd, Rh, etc. (see col. 1, ln 40-57). See also Table ^{II} ~~II~~ in col. 4, catalyst 11.

There is no patentable distinction seen between the claimed catalyst and that disclosed by Monceaux, thus the claims are anticipated.

Citations

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

Conclusion

10. Claims 1-6 are pending. Claims 1-6 are rejected. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *cnn*
October 21, 2005

Cam Nguyen
CAM N. NGUYEN
PRIMARY EXAMINER

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